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EXAMINER

ROSE, SHEP K

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 09/24/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062602

Applicant(s)

Examiner

S. H. Raso

Group Art Unit

1612

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 & 17 is/are pending in the application.
- Of the above claim(s) 1 & 9 11 & 17 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 10 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1 & 9 11 & 17 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

The July 23 2003 response to the outstanding election of species requirement is an election, with traverse, of a two silica abrasive dentifrice (claim 10). Accordingly, claims 1 to 9, 11, 12, which do not recite or require any second silica abrasive (as elected) in the silica gel abrasive dentifrice, are hereby withdrawn, Rule 142(B), as non-elected subject matter.

Claims 13 to 17 are also withdrawn, Rule 142(B) as to the non-elected process of making an abrasive silica of two silica gels, not requiring parameters (A) (B) (C) (D) and PCR of the elected dentifrice.

The elected subject matter is a dentifrice classified in 424/49, invention III on page 2 of the outstanding March 19, 2003 35 USC 121 restriction requirement, hereby made final, the elected (invention III) dentifrice subject matter does not require a search in either of (A) or (B):

A class 423, subclass 339, for the non-elected invention I claims 13 to 17 for the non-elected process claims 13 to 17, of making an abrasive silica of two silica gels, or (B) does not require a search in class 51 subclass 308 for the non-elected silica abrasive of non-elected claims 1 to 5.

Contrary to applicants' attorneys remarks, there would be a serious burden on the USPTO examiner to conduct these non-mandatory fields of search for the non-elected matter; as well as for the elected subject matter of claim 10 which is to the concept of a two silica abrasive dentifrice, a burdensome search in itself.

Applicants' attorneys' remarks concerning the USPTO imposed restriction and election of species requirements (both hereby made hereby made FINAL), have been considered, but are not persuasive.

It is not controverted that non-elected inventions I and II silica abrasives, and the processes of making them are useful for non-dentifrice scouring powders, cleansers, cleaning and polishing dentures and other in animate surfaces, e.g. ceramic tiles, stained dishware, etc. moreover,

Robinson et al U.S. 6416744 (7/02, filed June 21, 2001) describes silica gel as well as precipitated silica abrasives having claim recited Einlehner hardeners and particle sizes can remove stains from teeth in chewing gum, (424/48) as opposed to dentifrice (424/49) as presented herein.

Moreover, U.S. patents to Thomas et al (II - III - IV), (cited on PTO-892, but not on the PTO-1449) (commonly assigned), are considered not one material, relevant, and important to the issue of USPTO restriction practice but also to 35 USC 102(e) with respect to the state of the prior art of two silica abrasive dentifrices (as elected, claim 10 herein) as if applicants, January 31, 2001 priority date.

The scope of the second silica abrasive of elected claim 10 not only encompasses silica gel abrasives, and precipitated silica abrasives, according to the recitals of example 2, page 11 herein, such as (B) sylodent 783 (example 1, pages 10 and 11 herein) silica gel abrasive, Einlehner abrasion-1, 2, PCR-72, RDA-117, and 1or (c) an unspecified precipitated silica abrasive, Einlehner abrasive-6.4, PCR 72, RDA 83.

Herein, in elected claim 10, (A) a silica gel abrasive, Einlehner abrasion value 0.6-1.6, PCR-107, RDA-120-150, is combined with (B) or with (c), (as noted above), in a two silica abrasive dentifrice, (as elected herein).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Durga et al U.S. 6290933 (9/01, filed 5/9/2000) describes a second silica abrasive included in a high cleaning low abrasion dentifrice comprised of sylodent XWA (300 or 650) silica of claim 10 as elected herein, namely:

- (a) particle size-5 to 12 microns;
- (b) Einlehner hardness-1 to 20;
- (c) RDA-110 to 200
- (d) PCR-150 to 300 (see claims 1 and 7, column 2, lines 43 to 59, column 3, lines 1 to 65, column 4, lines 10 to 29 and especially lines 30 to 35 columns 7, 8 and 9, Tables I , II and III of Durga et al who include in the dentifrice with the sylodent XWA 300 and 650 silica hydrogel abrasive, either sylodent 783 silica hydrogel abrasive (same as applicants herein) or else zeodent 115 precipitated silica abrasive (same as applicants herein/as a second abrasive.

It is noted (for the record) that applicants did cite on the IDS Santa Lucia et al U.S. 5939051(8/99) as a prior art two silica abrasive dentifrice, one of (A) sylodent

Art Unit: 1614

XWA 300 and (B) a second silica abrasive, sylodent 783 (silica gel) or zeodent 115 (precipitated silica).

However, Santalucia et al, (unlike Durga et al) is silent on the Einlehner abrasive property values recited and required by applicants' claim 10 and patent commissioner Kunin in a current memorandum of policy to USPTO Examiners, has seemingly undermined the previous USPTO practice on inherent parameters, now the USPTO Examiner has the burden of proof, (with no laboratory, no means to prove the inherent Einlehner abrasion property values) of any prior art reference that is silent on this or (any inherent) property or parameter.

The Courts have held that there is no requirement that those of ordinary skill in the art know of the inherent property. See MPEP 2131.01(d) and MPEP § 2113 for case law on inherency. Also note that the critical date of extrinsic evidence showing a universal fact need not antedate the filing date. See MPEP § 2124.<

Atlas Powder Co. V. IRECO, 51 USPQ2d 1943 (Fed. Cir. 1999)

"Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art... However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." The Court further held that "this same reasoning holds true when it is not a property but an ingredient which is inherently contained in the prior art".

Art Unit: 1614

Mehl/Biophile International Corp. V. Milgraum, 52 USPQ2d 1303 (Fed. Cir. 1999) Thus viewed as a whole, the Polla disclosure shows that the "natural result flowing from the operation as taught would result in alignment of the laser light over the hair follicle, as claimed." This was true even though Polla did not mention the goal of hair removal. Therefore, the Court held that the '192 patent was invalid as anticipated.

Where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may be an inherent characteristic of the prior art, it has the authority to require the applicant to prove that the subject matter shown in the prior art does not possess the characteristics relied on. In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01.

INHERENCY OF METHODS. Ex parte Novitski 26 USPQ 1389 (BPAI 1993)

Mehl/Biophile International Corp. V. Milgraum, 52 USPQ2d 1303 (Fed. Cir. 1999)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shep Rose whose telephone number is (703) 308-4609. The examiner can normally be reached on Monday, Tuesday, and Thursday 7:30am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 10/062,602

Page 7

Art Unit: 1614

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



**SHEP K. ROSE
PRIMARY EXAMINER**

Rose/tgd
September 16, 2003